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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,034	11/18/2003	Masayoshi Nanami	FY.F5642US2C	7337

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EXAMINER

VASUDEVA, AJAY

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/717,034

Applicant(s)

NANAMI ET AL.

Examiner

Ajay Vasudeva

Art Unit

3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 25-33 is/are rejected.
- 7) ☒ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

- A roll sensor, as set forth in claim 30.
- A roll signal, as set forth in claim 30.
- A sensor configured to detect a rolling motion, as set forth in claims 25 and 30.
- The sensor detecting the rolling motion in...a rotational direction about a longitudinal axis of the hull, as set forth in claims 25 and 30.
- The sensor detecting the rolling motion...if the hull has rolled beyond a predetermined angle, as set forth in claims 25 and 30.
- A timer, or clocking the sensor with a timer (claim 28).
- Resetting the timer (claim 28).

Note: No new matter should be introduced.

2. On page 22 (line 6), change “**continuos**” to – **continuous** --. (two occurrences).

3. On page 1 (line 1), applicant must furnish the appropriate US Patent numbers resulting from the allowed parent applications.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

Art Unit: 3617

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 25-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification, as originally filed in the parent applications, in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 25 and 30, applicant has claimed an apparatus an associated method that sets forth the following:

- (i) A sensor configured to detect a rolling motion.
- (ii) The sensor detecting the rolling motion in a rotational direction about a longitudinal axis of the hull.
- (iii) The sensor detecting the rolling motion if the hull has rolled beyond a predetermined angle.
- (iv) Clocking the sensor with a timer, or resetting the timer.

However, it is noted that the originally filed specifications of the parent applications provide no disclosure of such limitations, as recited above. There is no disclosure of a sensor configured to detect either a rolling motion, or any motion in relationship to a longitudinal axis of the hull. Further, there is no disclosure of detecting the rolling motion beyond a predetermined angle.

Note: The applicant is reminded that inclusion of new matter, which is not supported in the specification as originally filed, is not permitted. However, new matter may be incorporated by filing a Continuation-In-Part (CIP) application.

Art Unit: 3617

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 25-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 25 and 30, a use of the limitation "rolling motion" makes the claims indefinite for failing to adequately define the meaning of the limitation, or to define its metes and bounds. It is noted that the commonly accepted meaning of such phrase in the art is "the oscillatory motion about a longitudinal axis of the boat." However, the disclosure of the instant application is limited to defining an overturning of the boat by tilting or listing. It is not clear from applicant's disclosure whether "rolling motion" has been used to indicate a tilting motion in a single direction, or if it is intended to encompass a back-and-forth motion -- whether linear or rotational.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 25, 26 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsunamoto et al. (US 4,871,996 A) in view of Nitta et al. (US 5,846,102 A).

Art Unit: 3617

Tsunamoto et al. shows a sensor [42] configured to detect a tilting motion of the watercraft (col. 3, lines 39-50), and emitting a signal if the hull has tilted beyond a predetermined angle when overturned. A warning device is activated if signal is emitted for at least a predetermined time (col. 3, line 49).

Tsunamoto et al. shows all features of claims 25 and 30, except the disabling of the engine when the watercraft is overturned.

Nitta et al. shows a watercraft that shows disablement of the engine when the watercraft is overturned (col. 14, lines 35-55; and figures 4b and 4c).

It would have been obvious for one skilled in the art at the time of the invention to modify the watercraft of Tsunamoto et al., as taught by Nitta et al., so that the engine was disabled simultaneously with the activation of the warning device. Such modification would have protected the user from injury from other boats in the vicinity, as well as from the personal overturned boat. Further, disabling of the engine would help conserve fuel until the operator was ready to right the watercraft for use again.

Allowable Subject Matter

10. Claims 27-29 and 33 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first as well as second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Art Unit: 3617

Conclusion

11. The prior art made of record in the attached PTO Form 892, but not yet relied upon, is considered pertinent to applicant's disclosure.

12. Note: Applicant is cautioned that the amended claims will be reviewed for double patenting issues with regard to the issued parent application.


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay Vasudeva whose telephone number is (703) 306-5992. The examiner can normally be reached on Monday-Friday 1:00 pm--5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano can be reached on (703) 308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Ajay Vasudeva
Examiner
Art Unit 3617


S. JOSEPH MORANO
SUPERVISORY PATENT EXAMINER
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